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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,443	01/29/2001	Robert Gordon	19388- P002us	1042
7590	02/11/2005		EXAMINER	DAY, HERNG DER
James J. Murphy Winstead Sechrest & Minick 5400 Renaissance Tower 1201 Elm Street Dallas, TX 75270			ART UNIT	PAPER NUMBER
			2128	
			DATE MAILED: 02/11/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/772,443	GORDON ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Herng-der Day	2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 18 October 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-3 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 29 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. This communication is in response to Applicants' Amendment and Response ("Amendment") to Office Action dated May 14, 2004, mailed October 14, 2004, and received by PTO October 18, 2004.
  - 1-1. Claim 1 has been amended. Claims 2-3 have been added. Claims 1-3 are pending.
  - 1-2. Claims 1-3 have been examined and rejected.

### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
  - (a) "Say to Other Jurors" button 645, as described in line 12 of page 38.
  - (b) 1110, "SUBMIT" button 1130, and "CANCEL" button 1120, as described in lines 16, 18, and 19 of page 53.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The disclosure is objected to because of the following informalities:

Appropriate correction is required.

  - 3-1. It appears that "RAM 214", as described in line 6 of page 16, should be "RAM 1314".

**3-2.** It appears that “and “whispers” between pairs of jurors in Step 420”, as described in line 11 of page 21, should be “and “whispers” between pairs of jurors in Step 430”.

**3-3.** It appears that “if jurors decide to whisper amongst themselves in Step 330”, as described in line 13 of page 23, should be “if jurors decide to whisper amongst themselves in Step 430”.

**3-4.** It appears that “he may view this in Step 355”, as described in line 1 of page 24, should be “he may view this in Step 335”.

**3-5.** It appears that “FIGURE 500”, as described in line 14 of page 32, should be “FIGURE 5”.

***Claim Rejections - 35 USC § 112***

**4.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**5.** Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**5-1.** Claim 1 recites the limitations “the group of triers of fact” and “the triers of fact” in lines 14 and 16 of the claim. There is insufficient antecedent basis for any of these limitations in the claim. For the purpose of claim examination, the Examiner will interpret “the group of triers of fact” as “the group of virtual triers of fact” and interpret “the triers of fact” as “the virtual triers of fact”.

**5-2.** Claim 2 recites the limitations “the triers of fact” in lines 1-2, “one or more triers of fact” in line 2, and “the observation room” in line 3 of the claim. There is insufficient antecedent basis

for any of these limitations in the claim. For the purpose of claim examination, the Examiner will respectively interpret “the triers of fact” as “the virtual triers of fact”, “one or more triers of fact” as “one or more virtual triers of fact”, and “the observation room” as “the virtual observation room”.

5-3. Claim 3 recites the limitations “the triers of fact” in lines 1-2, “the observation room” and “one or more triers of fact” in line 3 of the claim. There is insufficient antecedent basis for any of these limitations in the claim. For the purpose of claim examination, the Examiner will respectively interpret “the triers of fact” as “the virtual triers of fact”, “the observation room” as “the virtual observation room”, and “one or more triers of fact” as “one or more virtual triers of fact”.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over i-Courthouse Press Releases, “I-Courthouse Opens its Doors to Jury Trials On-Line”, November 8, 1999, [http://www.i-courthouse.com/main.taf?areal\\_id=about&area2\\_id=pressreleases](http://www.i-courthouse.com/main.taf?areal_id=about&area2_id=pressreleases), in view of Glynn et al., “GSS for Jury Deliberations: Applying Technology in the High School Courtroom”, Proceedings of the Thirty-First Hawaii International Conference on System Sciences, January 1998.

7-1. Regarding claim 1, i-Courthouse discloses a method of conducting a mock trial via a computer network (on-line jury trials, paragraph 1, page 1) comprising the steps of:

developing case information for presentation to a selected group of virtual triers of fact

(Plaintiffs and defendants are issued Trial Books where they post their arguments and evidence, paragraph 3, page 1);

storing the case information in a computer database (Their case is placed in the docket area, paragraph 3, page 1);

setting up a virtual jury room for establishing communications (Everything takes place on-line, paragraph 3, page 1) [between the virtual triers of fact];

setting up a virtual observation room supporting observations of selected communications in the virtual jury room (Everything takes place on-line, paragraph 3, page 1) [between the virtual triers of fact and] between the virtual triers of fact and observing parties in the virtual observation room (Jurors ... are able to post questions to the litigants, paragraph 3, page 1), the observing parties selected from a group of observing parties selected from the group including scientists, judges, lawyers (Litigants; paragraphs 3 and 4, page 1);

selecting the group of virtual triers of fact (choose specific jurors, paragraph 4, page 1);

selectively presenting the case information in the computer database to each of the virtual triers of fact via the computer network (Jurors review the contents of the Trial Books, paragraph 3, page 1);

establishing communications [between the group of virtual triers of fact] using the virtual jury room (Everything takes place on-line, paragraph 3, page 1); and

observing selected communications [between the virtual triers of fact] in the virtual observation room (Litigants can monitor juror deliberations real-time; paragraph 4, page 1).

i-Courthouse fails to expressly disclose establishing and observing communications between the virtual triers of fact. Nevertheless, i-Courthouse does suggests litigants monitoring juror deliberations real-time and receiving a verdict summary after all the jurors have rendered their verdicts.

Glynn et al. disclose a Group Support System (GSS) for jury deliberations (Abstract). The system is typically based on a network of personal computers, usually one for each participant. A GSS enables a group to communicate simultaneously and the contributions made by each participant are immediately available to the rest of the group (paragraph 1, section: Defining Group Support Systems (GSS)). Furthermore, GSS allows for equal participation among jurors. Social status in groups becomes a less dominating factor. Strong (or loud) personalities find it difficult to dominate or sidetrack the group into an unproductive or irrelevant issue. All participants have an equal opportunity to contribute (paragraph 1, section: Deliberations Using GSS).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of i-Courthouse to incorporate the teachings of Glynn et al. to obtain the invention as specified in claim 1 because jury deliberation at current legal system is a group decision making process and the network implemented GSS allows for equal participation among jurors.

**7-2.** Regarding claim 2, i-Courthouse further discloses observing selected communications between the virtual triers of fact in the virtual observation room further comprises one or more

virtual triers of fact initiating communication with one or more observing parties in the virtual observation room (Jurors ... are able to post questions to the litigants, paragraph 3, page 1).

**7-3.** Regarding claim 3, i-Courthouse further discloses observing selected communications between the virtual triers of fact in the virtual observation room further comprises one or more observing parties in the observation room initiating communication with one or more virtual triers of fact in the virtual jury room (jurors answer questionnaires from the parties about the effectiveness of the evidence and arguments presented, paragraph 4, page 1).

### *Applicants' Arguments*

8. Applicants argue the following:

(1) "the instant invention, for the first time, allows a trial or jury scientist to forecast jury verdicts for clients by evaluating virtual juror voting patterns and using methods within the art of jury science to develop probabilities associated with each cause of action to forecast damages" (page 6, paragraph 1, Amendment).

(2) "Thus allowing the jury scientist to construct a juror pool based on various behavioral patterns exhibited in the chosen forum rather than just based on physical location" (page 6, paragraph 2, Amendment).

(3) "Succinctly stated, these processes include a number of novel concepts with respect to application of online jury science such as one-way mirror observation" (page 6, paragraph 3, Amendment).

(4) "the combination of references, taken together, does not disclose the limitations of claim 1. Moreover, there is no teaching, suggestion, or disclosure that would support the

combination of the Mock Trial, eShare and Street Smart references in the manner suggested by the Examiner" (page 6, paragraph 4, Amendment).

***Response to Arguments***

9. Applicants' arguments have been fully considered.
- 9-1. In response to Applicants' arguments (1)-(3) that the references fail to show certain features of Applicants' invention, it is noted that the features upon which Applicants rely (i.e., to forecast jury verdicts, evaluating virtual juror voting patterns, to develop probabilities, to forecast damages, to construct a juror pool based on various behavioral patterns, one-way mirror observation, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
- 9-2. Applicants' argument (4) is moot in view of the new ground(s) of rejection. The rejections of claim 1 under 35 U.S.C. 103(a) in the Office Action dated May 14, 2004, have been withdrawn.

***Conclusion***

10. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jean R. Homere can be reached on (571) 272-3780. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day *H.D.*  
February 3, 2005

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